AF/2822

#10 Reply Brief 7/30/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

CETIN KAYA

Serial No. 09/620,649 (TI-23686.1)

Filed July 20, 2000

For: INTEGRATED CIRCUIT HAVING INDEPENDENTLY FORMED ARRAY AND PERIPHERAL ISOLATIO DIELECTRICS

Art Unit 2822

Examiner M. Wilczewski

Commissioner for Patents
Washington, D. C. 20231

Sir:

REPLY BRIEF

In response to the Examiner's Answer, the sole true issue in this appeal is based upon whether Van Buskirk (U.S. 6,001,689) is a valid reference in this application under 35 U.S.C. 102(e) or 103(a). Though the Examiner's Answer has cited many cases, none relate in any way to the issue herein.

The filing of the provisional application prior to the parent of the subject application provides conception at least from the date of filing of the provisional application. This is not challenged by the Examiner's Answer which, in fact, agrees with appellant in this regard. Diligence is therefore proven conclusively from September 30, 1997 (the filing date of the provisional application) until abandonment of the provisional application (October 1, 1998, the day subsequent to one year after filing). The only issue

WRONG
No cannot rely on to establish diligence because prov appl. was abn

is remaining is whether there is diligence from October 1, 1998 until the filing of the parent of the subject application on October 7, 1998, this application being a division of the parent application and copending therewith.

The case law as well as the M.P.E.P. do not appear discuss provisional applications in this regard, so it is not clear that there is any pertinent law strictly on point. Clearly, the case law cited by the Examiner does not relate to provisional applications. However, the case law and the M.P.E.P are quite clear in stating that diligence does not require continual activity in the manner as set forth in the citations cited in the Brief on Appeal. An hiatus of 6 days does not amount to a lack of diligence when it was always the intention to prosecute the parent of this application with copendency with the provisional application as set forth in the Declaration of the undersigned which is a part of the amendment filed under 37 C.F.R. 116. This is not a pleading, as the Examiner's Answer cavalierly states, but an actual statement of facts.

provisional treated like foreign priority apps.

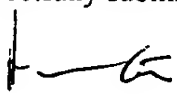
As to the issue of reduction to practice, again, no case law involving provisional application has been cited. However, it is agreed that the provisional application is a constructive reduction to practice when the regular application is filed within one year of the filing of the provisional application. Does the provisional application lose this constructive reduction to practice status by the non-filing of the regular application within one year of the filing of the provisional application? Apparently this issue has not been determined to date. Furthermore, even if this issue be decided adversely to appellant, the parent of the subject application is still, as agreed, a constructive reduction to practice as of its filing date with diligence clearly proven up to a period only six day prior to the filing of the parent of the subject application. Clearly, conception with timely reduction

to practice has been demonstrated, even if the provisional application not be a constructive reduction to practice.

Van Buskirk would be available as a reference in this case only if it bore a filing date more than one year prior to the parent of the subject application, which it does not. All that is lost by the error in failing to file the parent of the subject application within one year of the filing of the provisional application is the possibility that an invalidating reference appear which bears an effective date more than one year prior to the filing date of the parent of the subject application. No such reference has been found. Accordingly, for the reasons stated above as well as in the Brief on Appeal, Van Buskirk is not available as a reference in this application.

For the reasons stated above and in the Brief on Appeal, reversal of the rejection of the Examiner and allowance of the claims on appeal is urged that justice be done in the premises.

Respectfully submitted,



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